

REMARKS

In an office action dated 03 October 2003, the Examiner objects to the drawings, specification and claims 1, 46, and 68. The Examiner also rejects claims 1-96 (all pending claims). In response to the office action, Applicants amend the drawings, specification and claims. Applicants also respectfully traverse the rejections. In light of the amendments and following arguments, Applicants respectfully request that all objects and rejections be removed. Applicants further request that the Application be allowed.

Applicant has amended Figure 4 to change the wording from the data translator applications. Applicant has also amended the claims to correct the typographical and editorial errors cited by the Examiner. No new matter has been entered by these amendments.

The Examiner rejects claim 1 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number issued to Boals et al (Boals). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Amended claim 1 recites a configuration module of a configuration management system that employs initial input to identify and down load to said at least one mobile I/O device. Boals does not teach a configuration module that performs this limitation. Instead, Boals teaches a system in which electronic device (Stylus) may be used to control a host system. There is no need in the Boals system to identify the device from

initial input as the Boals system already knows the type of device sending the data. In the claimed invention, the type of device may not be known as the device may be one of any number of types. There is a need to identify the hand held device by the configuration system. The system may then send signals to the mobile device to enable functions in order to increase the accuracy of data provided. Applicants have read the entirety of the Boals reference and have found no reference to identifying the mobile device. Thus, Boals does not teach each and every limitation of amended claims. Therefore, Applicants request that the rejection to claim 1 be removed and amended claim 1 be allowed.

Claims 2-12 are dependent upon amended claim 1 and are allowable as being dependent upon an allowable independent claim. Therefore, applicants respectfully request that the rejections of amended claims 2-12 be removed and claims 2-12 be allowed.

The Examiner rejects Claim 13 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number issued to Boals et al (Boals). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Amended claim 13 recites that hand-held device that includes a plurality of software modules residing in a memory such that at least one of the plurality of enableable functions. Boals does not teach this limitation. Instead, Boals teaches a system

in which a mobile device (Stylus) used to control a host system. There is no teaching in Boals of the host system being used to enable functions in stylus. This is because there is no need for this in a Boals system because the remote device is controlling the host system and not the other way around. Applicants have read the entirety of the Boals reference and cannot find any reference to function in the remote device that may be enabled by the host system. Therefore, Applicants request that the rejection of claim 13 be removed and amended claim 13 be allowed.

Claims 14-21 are dependent upon claim 13. Thus, claims 14-21 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants respectfully request that the rejections of claims 14-21 be removed and claims 14-21 be allowed.

Claim 22 recites a configuration management including a configuration module as recited in claim 1. Therefore, claim 22 is allowable for at least the same reason as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 22 be removed and claims 22 be allowed.

Claims 23-29 are dependent upon claim 22. Thus, claims 23-29 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants respectfully request that the rejections of claims 23-29 be removed and claims 23-29 be allowed.

Claim 30 recites a method for using the system recited in claim 1. Therefore, claim 30 is allowable for at least the same reasons as amended claim 1. Thus, Applicants respectfully request that the rejection to claim 30 be removed and claim 30 be allowed.

Claims 31-37 are dependent upon claim 30. Thus, claims 31-37 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants respectfully request that the rejections of claims 31-37 be removed and claims 31-37 be allowed.

The Examiner rejects Claim 38 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number issued to Boals et al (Boals). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

The Examiner states that Boals inherently teaches a method for configuring a hand-held device. In order to support an anticipation rejection based on **inherency**, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). Applicants submit that the Examiner has not made a prima facie case of anticipation of claim 38. The Examiner asserts that Boals teaches a configurable hand-held device. And thus inherently teaches a method of configuring the system. Applicants have read the entire Boals reference and have found no teaching in the reference of a host system that downloads software to the remote device in order to configure the hand-held device. Instead, Boals is teaching a system in which a stylus is used to control a remote host system. Even if there is a

teaching of configuring the hand held device, the specific steps of claim 38 are not inherently taught as there may be more than one way to configure a hand held device. Therefore, Applicants respectfully request that the rejection to claim 38 be removed and claim 38 be allowed.

Claims 39-45 are dependent upon claim 38. Thus, claims 39-45 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants respectfully request that the rejections of claims 39-45 be removed and claims 39-45 be allowed.

The Examiner rejects Claim 46 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number issued to Boals et al (Boals). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Claim 46 recites the same configuration module that uses initial input to identify a device as recited in claim 1. Thus, claim 46 is allowed for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection to claim 46 be removed and amended claim 46 be allowed.

Claims 47-58 are dependent upon claim 46. Thus, claims 47-58 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants

respectfully request that the rejections of claims 47-58 be removed and claims 47-58 be allowed.

The Examiner rejects Claim 59 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number issued to Boals et al (Boals). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Claim 59 recites that potable I/O device that includes a plurality of software modules residing in a memory such that at least one of the plurality of enableable functions. Boals does not teach this limitation. Instead, Boals teaches a system in which a mobile device (Stylus) used to control a host system. There is no teaching in Boals of the host system being used to enable functions in a stylus. This is because there is no need for this in a Boals system because the remote device is controlling the host system and not the other way around. Applicants have read the entirety of the Boals reference and cannot find any reference to function in the remote device that may be enabled by the host system. Therefore, Applicants request that the rejection of claim 59 be removed and amended claim 59 be allowed.

Claims 60-68 are dependent upon claim 59. Thus, claims 60-68 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants respectfully request that the rejections of claims 60-68 be removed and claims 60-68 be allowed.

The Examiner rejects Claim 69 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number issued to Boals et al (Boals). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Claim 69 recites the same configuration module that uses initial input to identify a device as recited in claim 1. Thus, claim 69 is allowed for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection to claim 69 be removed and amended claim 69 be allowed.

Claims 70-78 are dependent upon claim 69. Thus, claims 70-78 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants respectfully request that the rejections of claims 70-78 be removed and claims 70-78 be allowed.

The Examiner rejects Claim 79 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number issued to Boals et al (Boals). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

The Examiner states that Boals inherently teaches a method for configuring a portable I/O device. In order to support an anticipation rejection based on **inherency**, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). Applicants submit that the Examiner has not made a prima facie case of anticipation of claim 38. The Examiner asserts that Boals teaches a configurable portable I/O device. And thus inherently teaches a method of configuring the system. Applicants have read the entire Boals reference and have found no teaching in the reference of a host system that downloads software to the remote device in order to configure the hand-held device. Instead, Boals is teaching a system in which a stylus is used to control a remote host system. Even if there is a teaching of configuring the hand held device, the specific steps of claim 38 are not inherently taught as there may be more than one way to configure a hand held device. Therefore, Applicants respectfully request that the rejection to claim 38 be removed and claim 38 be allowed.

Claims 80-87 are dependent upon claim 79. Thus, claims 80-87 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants respectfully request that the rejections of claims 80-87 be removed and claims 80-87 be allowed.

The Examiner rejects Claim 88 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number issued to Boals et al (Boals). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v.*

Barient, Inc., 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

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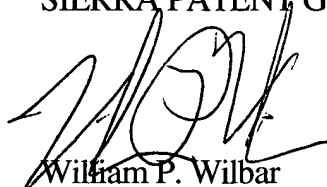
Claims 88-96 are dependent upon claim 87. Thus, claims 88-96 are dependent upon an allowable independent claims and are likewise allowable. Therefore, Applicants

respectfully request that the rejections of claims 88-96 be removed and claims 88-96 be allowed.

If the Examiner has any questions regarding this response or the application in general, the Examiner is invited to telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

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William P. Wilbar
Reg. No.: 43,265

Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500
(775) 586-9550 Fax